



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/656,894

09/08/2003

Michael A. Whitt

P-3558-US

1535

49443 7590 07/02/2008  
Pearl Cohen Zedek Latzer, LLP  
1500 Broadway  
12th Floor  
New York, NY 10036

EXAMINER

MARVICH, MARIA

ART UNIT

PAPER NUMBER

1633

MAIL DATE

DELIVERY MODE

07/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/656,894</p>	<p><b>Applicant(s)</b> WHITT ET AL.</p>	
	<p><b>Examiner</b> MARIA B. MARVICH</p>	<p><b>Art Unit</b> 1633</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 13 May 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 13 December 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-8, 15, 16, 18, 30-37, 42-45, 47, 49, 50, 57-60, 62, 63, 75, 77, 79-85 and 89-91.  
Claim(s) withdrawn from consideration: 9-14, 19-29, 38-41, 46, 48, 51-56, 64-74, 76, 78, 86-88 and 92-112.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: See Continuation Sheet.

/Maria B Marvich, PhD/  
Primary Examiner, Art Unit 1633

Continuation of 3. NOTE: Claim 45 has been amended such that it is drawn to a nucleic acid encoding a VSV genome wherein the genome "consists" of a deletion in amino acids 440-449 or 449-462. Hence, the scope of the claims have been amended from a nucleic acid "comprising" these mutations to one "consisting" thereof. The rejections are meant to overcome the art rejections under 35 USC 102. However, the change in scope necessitates a new search and consideration for new matter as well as art. Furthermore, the claim amendment necessitates new consideration of 112 second as it is not clear how a genome can consist of a deletion. Quite literally, this means the genome is a deletion and nothing more.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments are moot in view of the non-entry of the amendment. However, it is noted that had applicants' amendment been entered, the objections to claims 5 and 34 would have been overcome. Applicants' argue that claims 59 and 81 have been cancelled, thus obviating the need to amend these claims. However, claims 59 and 81 are not indicated as cancelled. Hence, the claim objections would not have been overcome. As well, the rejection of claims 6, 35, 47, 77 and 82 under 35 USC 112, first paragraph would have been overcome by amendment limiting the M and G proteins to that from VSV. Finally, the rejections under 35 USC 102 would have been overcome.

Continuation of 13. Other: Applicants arguments for entry of the amendment filed 5/13/08 have been considered but are not persuasive for the following reasons. The MPEP teaches as guidance, "The following types of amendments are ordinarily denied entry:

(A) An amendment presenting an unpatentable claim, or a claim requiring a new search or otherwise raising a new issue in an application whose prosecution before the primary examiner has been closed." In this case as set forth above, the claims are not patentable as new issues and new considerations are necessary based upon the amendment.